

REMARKS

Claims 2-5, 16-19 and 33 are pending in the application. Claim 33 is independent. No claims have been amended, canceled, withdrawn, or added.

Rejection of Claims 2, 5, and 33 Under Obviousness-Type Double Patenting

In paragraph 2 of the Office Action, the Examiner rejected claims 2, 5, and 33 under Obviousness-Type Double Patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,665,321 to Sochava et al. (hereinafter "Sochava"). Specifically, the Examiner states that although the claims are not identical, they are not patentable distinct from each other because they have the same elements and structure. Applicants respectfully traverse the rejection.

Applicants have submitted a Terminal Disclaimer disclaiming the terminal part of any patent granted on the present application that would extend beyond the expiration of the full statutory term of U.S. Patent No. 6,665,321 to Sochava. Accordingly, Applicants respectfully submit that the Obviousness-Type Double Patenting rejection has been overcome and requests that the Examiner reconsider and remove the rejection to claims 2, 5, and 33.

Rejection of Claims 7 and 33 Under Obviousness-Type Double Patenting

In paragraph 2 of the Office Action, the Examiner rejected claims 7 and 33 under Obviousness-Type Double Patenting as being unpatentable over claims 31, 43, and 56 of U.S. co-pending patent application Serial No. 09/900,426 to Daiber et al. (hereinafter "Daiber"). Specifically, the Examiner states that although the claims are not identical, they are not patentable distinct from each other because they have the same elements and structure. Applicants respectfully traverse the rejection.

Applicants have submitted a Terminal Disclaimer disclaiming the terminal part of any patent granted on the present application that would extend beyond the expiration of the full statutory term of any patent issuing on Serial No. 09/900,426 to Daiber. Accordingly, Applicants respectfully submit that the Obviousness-Type Double Patenting rejection has been overcome and requests that the Examiner reconsider and remove the rejection to claims 7 and 33.

Rejection of the Claims 2-5, 16-19, and 33 Under 35 U.S.C. § 102(e)

In paragraph 3 of the Office Action, the Examiner rejected claims 2-5, 16-19, and 33 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application No. 6,600,760 B1 to Green et al. (hereinafter “Green”). Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236 (Fed. Cir. 1989)).

Claim 33 recites in pertinent part:

“a laser mode tuning assembly operatively coupled to the end mirror ***to adjust the position of the end mirror to adjust the optical path length*** of the external cavity to lock the laser onto a peak of a first passband, the first passband representing the laser mode;

a laser channel selector positioned in the optical path; and

a laser channel tuning assembly operatively coupled to the laser channel selector ***to adjust the position of the laser channel selector to lock the laser channel*** onto a peak of a second passband, the second passband representing the laser channel,

the laser channel tuning assembly further coupled ***to adjust the position of the laser channel selector to unlock the laser channel*** from the peak of the second passband, while the laser mode tuning assembly is to maintain the laser mode locked onto the first passband” (emphasis added).

The Examiner asserts that Green discloses a laser, comprising: a gain medium 224 having first 228 and second output facers 226, the gain medium 224 emitting a coherent beam from the first output facet 228 along an optical path; an end mirror 264 located in the optical path, the end mirror 264 and the second output facet 226 defining an external cavity, a laser mode selector 246 positioned in the optical path before the end mirror 264, a ***laser mode tuning assembly 262 operatively coupled to the end mirror 264 to adjust the optical path length*** of the external cavity to lock the laser onto a peak of a first passband, the first passband representing a

laser mode; a laser channel selector 252 positioned in the optical path; and laser channel tuning assembly 254 operatively coupled to the laser channel selector 252 to adjust the position of the laser channel selector 252 to lock the laser channel onto a peak of a second passband, the second passband representing the laser channel, the laser channel tuning assembly further coupled to adjust the position of the laser channel selector to unlock the laser channel from the peak of the second passband, while the laser mode tuning assembly is to maintain the laser mode locked onto the first passband because the grid control 248 and channel tuner 254 are independent (emphasis added).

Applicants respectfully disagree with the Examiner's characterization of Green. In column 7, lines 19-28 Green teaches that "Channel selection in this embodiment of the invention is brought about by *changes in the optical path length* 256 of the channel selector. This in turn *may result from either or both a change in the index of refraction of the channel selector 252 or of its thickness along the optical path*, which in this case is aligned with the "z" axis. In the embodiment shown, the second thermal actuator 250 provides a temperature sink/source to decrease/increase the temperature of the channel selector 252 under the control of the channel tuner 254. This decreases/increases the optical path length of the channel selector" emphasis added. Thus, contrary to the Examiner's assertion, Green fails to teach "a laser mode tuning assembly operatively coupled to the end mirror *to adjust the position of the end mirror to adjust the optical path length* as recited in claim 33. Green therefore fails to teach the identical invention recited in claim 33. Applicants respectfully submit that Green fails to anticipate claim 33 and thus claim 33 is patentable over Green. Claims 2-5 and 16-19 properly depend from claim 33 and Applicants respectfully submit that claims 2-5 and 16-19 are also patentable over Green. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 2-5, 16-19, and 33.

CONCLUSION

The Applicant submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: July 15, 2004

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